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| 10/802,359 | 03/16/2004 | Benjamin Silberstein | | 3792 |

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06/07/2006

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New York, NY 10017

EXAMINER

ALLEN, WILLIAM J

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/802,359 | SILBERSTEIN ET AL. | |
| | Examiner | Art Unit | |
| | William J. Allen | 3625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 04 May 2006.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 21-45 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 21-45 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

Application/Control Number: 10/802,359
Art Unit: 3625

Page 2

DETAILED ACTION

Prosecution History Summary

Claims 1-20 have been canceled per applicant's amendment filed 2/1/2006.

Claims 21-45 have been added and are currently pending.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 21-22, 25-34, and 36-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgato (US 5,950,178) in view of Tcharnyi (CA 2,343,448).**

Regarding claim 21, Borgato teaches:

providing a selection of rough stones to a customer by providing an inventory of uncut diamonds to potential willing buyers (see at least: col. 1 lines 38-40); and

allowing the customer to choose a specific rough stone from the selection of rough stones by allowing willing buyers to examine and evaluate the diamonds and negotiate a price (see at least: col. 1 lines 40-43).

Borgato teaches all of the above as noted and further teaches providing cut diamonds and selling the cut diamonds via a web service (see at least: abstract, col. 1 lines 16-18, col. 3 lines 46-48, Fig. 1 #18b). Borgato, however does not expressly teach *cutting the specific stone into at least two cut stones, selling the cut stones to the customer, and allowing the customer to present the cut stones to at least two recipients whereby the customer and the recipients have a specific sentimental relationship.*

Tcharnyi teaches:

cutting the specific stone into at least two cut stones (see at least: abstract, claims 1 and 2);

selling the cut stones to the customer, and allowing the customer to present the cut stones to at least two recipients whereby the customer and the recipients have a specific sentimental relationship (see at least: abstract, Background Paragraph 4, Summary Paragraphs 1-3). The Examiner notes that the consumer (i.e. *customer*) is sold the jewelry articles containing the set of gems from the original stone for use as wedding or engagement rings (i.e. *sentimental relationship*). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Borgato to have included *cutting the specific stone into at least two cut stones, selling the cut stones to the customer, and allowing the customer to present the cut stones to at least two recipients whereby the customer and the recipients have a specific sentimental relationship* as taught by Tcharnyi in order to provide higher emotional and symbolic value for consumers based on the unique and sole origin of the gems as being symbolic of the bonding and unity of the people possessing them (see at least: Tcharnyi, Summary Paragraph 3).

Regarding claims 22, Borgato teaches all of the above but does not expressly teach where *the customer and one of the recipients are the same person*. Tcharnyi further teaches where *the customer and one of the recipients are the same person* (see at least: abstract, Summary Paragraphs 1-3). The Examiner notes that the loose gems

set in the complimentary jewelry are sold as women's and men's engagement rings to a consumer (i.e. *customer*). The purchasing consumer (i.e. *customer*) is thereby either one of the man or woman in the engagement and represents *one of the recipients*. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Borgato to have included *the customer and one of the recipients are the same person* as taught by Tcharnyi in order to provide higher emotional and symbolic value for consumers based on the unique and sole origin of the gems as being symbolic of the bonding and unity of the people possessing them (see at least: Tcharnyi, Summary Paragraph 3).

Regarding claims 25-27, Borgato further teaches:

(25) *whereby the selection of rough stones has stones of different karat, color, and clarity* (see at least: col. 1 lines 13-14). Diamonds have unique "natural attributes" that include color, clarity, and weight (i.e. *karat weight*).

(26) *determining a cutting configuration for the specific stone* (see at least: abstract, col. 1 lines 16-18, col. 3 lines 46-48, Fig. 1 #18b). The Examiner notes that in order to provide a cut stone from an uncut stone, a *cutting configuration* is determined.

(27) *whereby the cutting configuration is any possible type of cut for a gemstone* (see at least: abstract, col. 1 lines 16-18, col. 3 lines 46-48, Fig. 1 #18b).

Regarding claim 28, Borgato teaches all of the above but does not expressly teach *mounting the at least two stones to at least to pieces of jewelry, the pieces of jewelry being presented to the recipients*. Tcharnyi further teaches *mounting the at least two stones to at least to pieces of jewelry, the pieces of jewelry being presented to the recipients* (see at least: abstract, claims 5-8, Summary Paragraphs 1-3). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Borgato to have included *mounting the at least two stones to at least to pieces of jewelry, the pieces of jewelry being presented to the recipients* as taught by Tcharnyi in order to provide higher emotional and symbolic value for consumers based on the unique and sole origin of the gems as being symbolic of the bonding and unity of the people possessing them (see at least: Tcharnyi, Summary Paragraph 3).

Regarding claims 29-33, Borgato teaches all of the above but does not expressly teach *wherein the sentimental relationship is husband and wife and persons to be engaged*. Tcharnyi teaches *wherein the sentimental relationship is husband and wife and persons to be engaged* (see at least: abstract, Summary Paragraph 1). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Borgato to have included *wherein the sentimental relationship is husband and wife and persons to be engaged* as taught by Tcharnyi in order to provide higher emotional and symbolic value for consumers based on the unique and sole origin of the gems as being symbolic of the bonding and unity of the people possessing them (see at least: Tcharnyi, Summary Paragraph 3).

Additionally regarding claims 29-33, claims 29-33 recite various types of sentimental relationships including *husband and wife, life partner, parent and child, persons engaged, and siblings*. Though Borgato in view of Tcharnyi does not expressly show sentimental relationships including *life partner, parent and child, and siblings* as recited in claims 30-32 respectively, Borgato in view of Tcharnyi does show *husband and wife* and *persons to be engaged* (see at least: abstract). The differences, however, amount to emotional/sentimental associations between people, which in turn amount to changes in degree of the relationship types taught rather than a change in kind which would move to effect some material and non-obvious variant of the method taught by Borgato in view of Tcharnyi. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have included any type of sentimental relationship because labeling the various types of relationships differently from that in the prior art would have been obvious.

Regarding claims 34 and 36, Borgato teaches **(34)** *wherein the step of providing a plurality of rough stones to a customer is presented over the internet* (see at least: abstract, col. 5 lines 10-15, Fig. 1) and **(36)** *wherein the step of providing a plurality of rough stones to a customer is presented over the catalog* (see at least: abstract, col. 5 lines 10-15, Fig. 1 and 6-10). The Examiner notes that the presentation of the categorized, listed stones constitutes an electronic catalog.

Regarding claims 37-40, Borgato teaches the use of **(claim 37)** *diamonds*, **(claim 38)** *rubies*, and **(claim 39)** *emeralds* (see: abstract, col. 5 lines 10-15). Borgato, however, does not expressly show the use of *sapphires* **(claim 40)**. Sapphires, however, are well known equivalent stones for the purposes taught by Borgato in view of Tcharnyi (i.e. represent a symbolic showing of sentiment and emotion).

Regarding claims 41-45, the limitations of claims 41-45 closely parallel the limitations of claims 21-22, 289-29, and 33. Claims 41-45 are thereby rejected under the same rationale.

3. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgato in view of Tcharnyi as applied to claim 21 above, and further in view of PTO 892 reference U (herein referred to as 892u).

Regarding claim 23, Borgato in view of Tcharnyi teaches all of the above as noted and further teaches multiple recipients for an item of jewelry (see at least: Tcharnyi, abstract). Borgato in view of Tcharnyi, however, does not expressly disclose *where a parent is the customer and the recipients are at least two children of the parent*. 892u teaches a mother purchasing gifts for her four children, thereby teaching *a parent is the customer and the recipients are at least two children of the parent* (see at least: 892u, abstract). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Borgato in view of Tcharnyi to have

Art Unit: 3625

included *a parent is the customer and the recipients are at least two children of the parent* as taught by 892u in order to provide a holiday gift that is more emotionally and symbolically linked to the recipients (see at least: Tcharnyi, Summary Paragraph 3; 892u Underlined).

Additionally regarding claims 23 and 24, claims 23 and 24 recite different types of customers and recipients including parents and grandparents as customers and children/grandchildren as recipients. Though Borgato in view of Tcharnyi in further view of 892u does not expressly show a grandparent as the customer and grandchildren as the recipients, Borgato in view of Tcharnyi in further view of 892u does show a mother as the customer and her children as the recipients of the gifts (see at least: 892u, abstract). The differences, however, amount to emotional/sentimental associations between people, which in turn amount to changes in degree of the relationship types taught rather than a change in kind which would move to effect some material and non-obvious variant of the method taught by Borgato in view of Tcharnyi in further view of 892u. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have included any type of sentimental relationship because labeling the various types of relationships differently from that in the prior art would have been obvious.

4. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borgato in view of Tcharnyi as applied to claim 21 above, and further in view of PTO 892 reference V (herein referred to as 892v).

Regarding claim 35, Borgato in view of Tcharnyi teaches all of the above including presenting the selection via a catalog and the Internet (see at least: abstract, col. 5 lines 10-15, Fig. 1 and 6-10). Borgato in view of Tcharnyi, however, does not teach wherein the selection is provided *at a retail store*. 892v teaches wherein the selection is provided *at a retail store* (see at least: Page 1, underlined). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Borgato in view of Tcharnyi to have included wherein the selection is provided *at a retail store* as taught by 892v in order to provide a purchaser of loose diamonds the ability to view the diamonds in a store first hand (see at least: 892v, Page 1 outlined).

Conclusion

The related art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 6145341 to Leong discloses uniquely mating jewelry items made from gems
- US 1,758,447 to Liebs discloses a mating finger ring
- US 2005/0187831 to Gershburg discloses a gem item reporting method and system
- US 3,755,025 to Jones discloses the production of doublet blanks for simulated diamonds
- PTO 892 reference W discloses two rings made using the metal from the same material
- PTO 892 reference X discloses the Soulmate Collection by JB Diamonds

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen
Patent Examiner
May 25, 2006



Jeffrey A. Smith
Primary Examiner